Patent
Attorney Docket No. 016660-049

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of
James Pei-Man She et al.
Application No.: 09/634,947
Filing Date: August 7, 2000
Title: METHOD AND APPARATUS FOR STREAMING OF DATA

Group Art Unit: 2153
Examiner: KRISNA LIM
Confirmation No.: 2827

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AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

☐ A Petition for Extension of Time is also enclosed.

☐ Terminal Disclaimer(s) and the ☐ $65.00 (2814) ☐ $130.00 (1814) fee per Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.

☐ Also enclosed is/are _____

☐ Small entity status is hereby claimed.

☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ $395.00 (2801) ☐ $790.00 (1801) fee due under 37 C.F.R. § 1.17(e).

☐ Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.

☐ Applicant(s) previously submitted _____
on _____,
for which continued examination is requested.

☐ Applicant(s) requests suspension of action by the Office until at least _____, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.

☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

☒ No additional claim fee is required.

☐ An additional claim fee is required, and is calculated as shown below.

AMENDED CLAIMS					
	No. of Claims	**Highest No. of Claims Previously Paid For**	**Extra Claims**	**Rate**	**Additional Fee**
Total Claims		MINUS =	0	x $50.00 (1202) =	$ 0.00
Independent Claims		MINUS =	0	x $200.00 (1201) =	$ 0.00
If Amendment adds multiple dependent claims, add $360.00 (1203)					
Total Claim Amendment Fee					$ 0.00
☐ Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					$ 0.00
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					**$ 0.00**

☐ A check in the amount of _____ is enclosed for the fee due.

☐ Charge _____ to Deposit Account No. 02-4800.

☐ Charge _____ to credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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By _____
James A. LaBarre
Registration No. 28,632

Date: December 29, 2004

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PATENT & TRADEMARK OFFICE

Patent
Attorney's Docket No. 016660-049

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In re Patent Application of	
James Pei-Man She et al.	Group Art Unit: 2153
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REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated September 29, 2004, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 28. The allowance of claims 1-9, 12-20, 22 and 25 is noted with appreciation.

Claim 28 was rejected under 35 U.S.C. §103, on the grounds that it was considered to be unpatentable over the newly-cited *Schreiber et al.* patent (U.S. 5,970,491). The statement of rejection alleges that the *Schreiber* patent discloses all of the subject matter recited in claim 28, with the exception of live data content as the information delivered via the gateways. Nevertheless, the Office Action contends that it would be obvious that the gateways of the *Schreiber* patent could be used for live data content.

Applicants respectfully submit that the Office Action does not provide any support for the contention of obviousness. Furthermore, other differences exist between the subject matter of claim 28 and the disclosure of the *Schreiber* patent, in addition to the nature of the information being delivered.

The three basic criteria for a *prima facie* case of obviousness are set forth in MPEP § 2143. The first of these criteria is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." With respect to this criterion, the MPEP goes on to state that "the teaching or suggestion to make the claimed combination...must...be found in the prior art, not in applicant's disclosure," citing In re Vaeck, 947F.2d 488, 20 USPQ2d 1438 (Fed. Cir., 1991).

It is respectfully submitted that the Office Action does not meet this requirement. It does not contain any showing, either in the *Schreiber* patent itself or elsewhere in the art, that would suggest the use of the *Schreiber* storage management system for the delivery of live data content. The *Schreiber* patent is particularly directed to email systems. In the background portion of the patent, it describes some of the difficulties that are encountered in email systems. These include the fact that different systems may operate with different protocols (column 1, lines 48-61), providing status feedback to message originators (column 1, line 62 to column 2, line 17), and the use of shared memory (column 2, lines 18-32). The rejection does not provide any showing that these problems are also associated with the delivery of live data content. Thus, there is no apparent reason for a person, who is concerned with the delivery of live data, to refer to the teachings of the *Schreiber* patent. Conversely, there is no motivation to modify the system of the *Schreiber* patent to deliver live data, since it is particularly directed to shortcomings of email systems.

For at least this reason, therefore, it is respectfully submitted that the Office Action has not established a *prima facie* case of obviousness.

Furthermore, even if one were to employ the system of the *Schreiber* patent to deliver live data content, such a modification would still fail to support the rejection. Another of the criteria set forth in MPEP §2143 is that "the prior art reference...must teach or suggest all the claim limitations." In setting forth the rejection, the Office Action states that each gateway of the *Schreiber* system is capable of acting as a source of data itself and is capable of sourcing data from another gateway, with reference to steps 440 of Figure 4C and 400 of Figure 4A. It is not apparent how these steps are being interpreted to suggest the claimed subject matter. Step 400 states that a message transfer agent (MTA) 106 accepts inbound information from a gateway. Step 440 states that the MTA calls a distribution management service (DMS) to retrieve a particular type of file. Even if step 400 could be considered to suggest that a gateway acts as a source of information, there is nothing in either of these two steps to suggest that such a gateway is also capable of sourcing data from another gateway. If the rejection is not withdrawn, the Examiner is requested to identify how these two steps, or any other portion of the *Schreiber* patent, are being interpreted to suggest that a gateway is capable of functioning not only as a source of data itself, but also can function to source data from another gateway. In the absence of such a showing, it is respectfully submitted that the rejection cannot be maintained.

In view of the foregoing, it is respectfully submitted that claim 28 is allowable over the cited prior art, in addition to the other pending claims. Reconsideration and withdrawal of the rejection, and allowance of all claims, is respectfully requested.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: December 29, 2004

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